

REMARKS/ARGUMENTS

The present amendment is submitted in an earnest effort to advance the case to issue without delay.

Independent claims 1 and 7 have been amended to specify the concentration of the lipophilic materials. Support is found at page 6, paragraph [00019]. The term "materials" is supported at page 4, second word of paragraph [00013].

Claims 1, 2 and 4-6 were rejected under 35 U.S.C. § 102(b) as anticipated by LaHann et al. (U.S. Patent 4,546,112). Applicant traverses this rejection.

LaHann utilizes lotions, creams, solutions and gels. All of these are emulsion compositions with substantial amounts of water. The emulsions among this group utilize no more than about 50% of emollients some of which may be characterized as lipophilic materials.

Amended independent claims 1 and 7 specify that the lipophilic material content of the skin pretreatment compositions must be at least about 90%. LaHann fails to disclose any pretreatment compositions where almost exclusively lipophilic materials are present. For this reason LaHann would not anticipate the claims.

Claim 3 was rejected under 35 U.S.C. § 103(a) as unpatentable over LaHann in view of Michaels et al. (U.S. Patent 3,843,780). Applicant traverses this rejection.

Fundamental to LaHann is the use of capsaicin as an active for preventing or reducing depilatory-caused dermal irritation. Capsaicin is used at relatively low levels. These small amounts indicate that the material is an active substance chemically interacting with receptors in the skin. Carriers for this active substance are reported to be lotions, creams, solutions and gels. All of these forms include very large amounts of water. None of the different forms has more than about 50% of emollients some of which are lipophilic materials.

In contrast to a chemically active substance, the present invention provides a skin pretreatment composition operating in a physical manner. Lipophilic materials are believed to coat the skin thereby serving as a blanket protection against the subsequent application of caustic depilatory. The depilatory "sees" the keratin fibers but is shielded by the lipophilic materials from contact with underlying skin.

Thus, the present invention differs in concept and composition from that of the primary reference. LaHann attenuates irritation through the chemical means of capsaicin. By contrast, applicant utilizes a physical blanket of lipophilic materials to separate the harsh depilatory from the skin but not from the keratin fiber. Applicant employs from 90 to 100% of lipophilic materials in the pretreatment composition. LaHann does not appreciate the physical approach nor suggests using extremely high levels of lipophilic materials. For these reasons, LaHann does not render the claims *prima facie* obvious.

Michaels et al. was introduced for teaching mineral oil as a pretreatment composition in shaving. There is a significant difference between shaving and depilatory treatment. The former utilizes a sharp blade while the latter is chemical. Methods and compositions which are useful against sharpened blades would not be

obvious substitutes for the quite different depilatory treatment. Those skilled in the art would not be likely to employ the teachings focused on razor technology into the depilatory arts.

Yet even if the LaHann and Michaels et al. references were combinable, the combination would still not provide a *prima facie* case of obviousness. The compositions of Michaels et al. utilize mineral oil at levels of maximum 85% by weight. See column 1, line 15. The remainder of the formula is anhydrous lower aliphatic monohydric alcohols. Aliphatic alcohol is defined as having from one to four carbon atoms, such as methanol, ethanol, propanol and butanol. See column 2, lines 39-42. These alcohols are not lipophilic materials.

A combination of LaHann in view of Michaels et al. would not render the present invention obvious. Neither of the references discloses upwards of 90% lipophilic materials. Further, there simply is no suggestion or incentive for incorporating mineral oil at even 85% as disclosed by Michaels et al. into the primary reference. Irritation caused by razor attack is much different than the effect of chemical burn.

Claims 7-10 were rejected under 35 U.S.C. § 103(a) as unpatentable over LaHann in view of Syed et al. (U.S. Patent 5,756,077). Applicant traverses this rejection.

Syed does not remedy the basic deficiency of LaHann. There is no disclosure of utilizing as a pretreatment a composition comprising at least 90% by weight of lipophilic materials. For this reason, the combination of art would not render the claims *prima facie* obvious.

The Examiner has commented upon instruction material as being not patentable. *In re Ngai*, 70 USPQ 2d 1862, CAFC 2004 was cited as controlling law. The case is quite distinguished from the present fact situation. In Ngai, the content of the kit other than the printed instructions did not differ from the prior art. The only physical element of the kit was a buffer. Ngai did not dispute that the kit with buffer lacked novelty under 35 U.S.C. § 102(b). The Court held that in a § 102(b) situation, printed instructions do not impart patentability. This was especially so since the printed matter (instructions for normalizing and amplifying RNA population) did not functionally relate to the product (buffer).

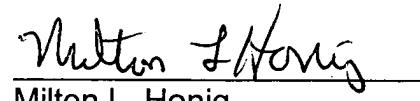
In the present fact pattern, applicant's kit has a skin pretreatment composition comprising 90-100% of lipophilic materials. This element of the kit clearly is not anticipated even absent the printed instruction element. Furthermore, the instructions to apply the pretreatment product to an area of skin and thereafter apply the depilatory product constitute a functional relationship between the printed matter and the products. Thus, the Court holding of *In re Ngai* actually would require the giving of patentable weight to the printed instructions.

Claim 10 has been changed to a method claim. This obviates the Examiner's view of the claims as being a product-by-process claim.

J6827(C)
02-0314-CPI

In view of the foregoing amendment and comments, applicant requests the Examiner to reconsider the rejections and now allow the claims.

Respectfully submitted,


Milton L. Honig
Milton L. Honig
Registration No. 28,617
Attorney for Applicant(s)

MLH/sm
(201) 894-2403